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PATENT APPLICATION

ATTORNEY DOCKET NO. 10011462-1

IN THE

UNITED STATES PATENT AND TRADEMARK OFFICE

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, Colorado 80527-2400

Confirmation No.: 5327

Inventor(s): Kennedy et al.

Examiner: Qin, Yixing

Application No.: 10/054,156

Group Art Unit: 2825

Filing Date: 11/13/2001

Title: Just-In-Time Printer Discovery and Driver Installation System and Method

Mail Stop Appeal Brief-Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450TRANSMITTAL OF APPEAL BRIEFTransmitted herewith is the Appeal Brief in this application with respect to the Notice of Appeal filed on 08/17/07

The fee for filing this Appeal Brief is \$510.00 (37 CFR 41.20).
 No Additional Fee Required.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

(a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d)) for the total number of months checked below:

 1st Month
\$120 2nd Month
\$460 3rd Month
\$1050 4th Month
\$1640

The extension fee has already been filed in this application.
 (b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

Please charge to Deposit Account 08-2025 the sum of \$ 510. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees.

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Signature: JoAnn Sismilich

Respectfully submitted,

Kennedy et al.

By Robert C. Sismilich

Robert C. Sismilich

Attorney/Agent for Applicant(s)

Reg No.: 41,314

Date: 10/16/07

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IIP Docket No. 10011462-1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No.	: 10/054,156)
Conf. No.	: 5327)
Appellant	: Kennedy et al.)
Filed	: 11/13/2001)
Title	: Just-In-Time Printer Discovery and Driver Installation System and Method)
TC / Art Unit	: 2625)
Examiner	: Qin, Yixing)
Docket No.	: 10011462-1	10/17/2007 PCHOMP
Customer No.	: 022879	00000020 082025 10054156 01 FC11462) 510.00 DA

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPELLANTS' APPEAL BRIEF

Sir:

Appellants are appealing from the Final Rejection of claims 1-7, 9, 11-27, and 30-36 in an Office Action dated 05/02/2007 and maintained in an Advisory Action dated 07/25/2007. The Notice of Appeal was filed on 08/17/2007.

I. REAL PARTY IN INTEREST

The real party in interest is Hewlett-Packard Development Company, LP, a limited partnership established under the laws of the State of Texas and having a principal place of business at 20555 S.H. 249 Houston, TX 77070, U.S.A. (hereinafter "HPDC"). HPDC is a Texas limited partnership and is a wholly-owned affiliate of Hewlett-Packard Company, a Delaware Corporation, headquartered in Palo Alto, CA. The general or managing partner of

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HPDC is HPQ Holding, LLC.

II. RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to the real party in interest which will directly affect or be directly affected by, or have a bearing on, the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

Claims 1-7, 9, 11-27, and 30-36 are pending. Claims 8, 10, and 28-29 have been previously canceled. All of claims 1-7, 9, 11-27, and 30-36 stand finally rejected. The Appellants appeal the final rejection of claims 1-7, 9, 11-27, and 30-36.

IV. STATUS OF AMENDMENTS

On 06/29/2007 a response after final rejection was filed that requested reconsideration. No amendment was made to the claims. In an Advisory Action of 07/25/2007, the Examiner indicated that the request for reconsideration filed on 06/29/2007 had been considered and the final rejection maintained as to all pending claims.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The summary is set forth in exemplary embodiments. Discussion of the claimed subject matter can be found at least at the locations in the specification and drawings as identified below.

Independent claims 1, 9, 15, 23, 30, and 31 are under appeal. The claimed subject matter relates to determining information regarding at least one printer available to receive a print job from a client computer. In environments that share multiple printers over a network,

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the present invention advantageously allows users at client computers – including users who do not regularly print to a particular printer – to easily find network printers (including the printer type and its physical location), and install and perhaps remove an appropriate printer driver in the client computer for use with the particular printer. Figs. 2 and 3 of the present application are reproduced below.

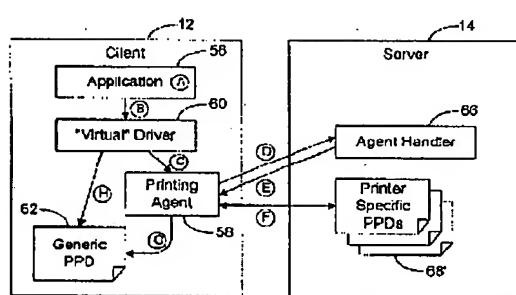


FIG. 2

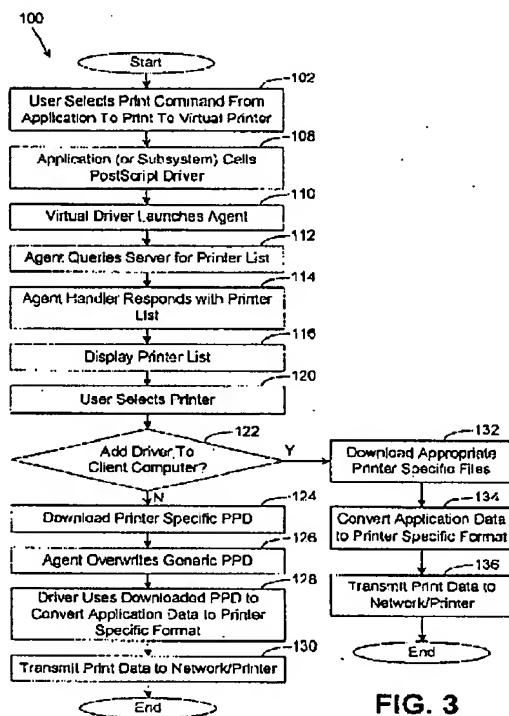
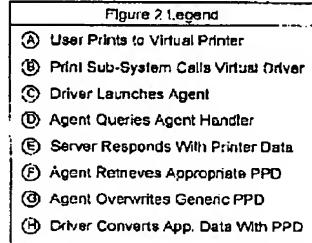


FIG. 3

Independent claim 1 recites a method of determining information regarding at least one physical printer available to receive a print job from a client computer (p.2, ln. 7-9). With reference to Figs. 2 and 3, the method includes calling 108 (Fig. 3) a general printer driver 60 directly from an application 56 (Fig. 2) executed by the client computer 12 (Fig. 2) (p.10, ln. 13-15). The general printer driver 60 (Fig. 2) is accessible as a destination printer 106 (Fig. 4) in a print menu 106 (Fig. 4) (p.10, ln. 8-9). The method also includes transmitting 112 (Fig. 3) a query from the client computer 12 (Fig. 2) to a server 14 (Fig. 2)

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via a network 40 (Fig. 1) for an identification of the at least one available physical printer 16a,16b,16n,44 (Fig. 1) (p.10, ln.31-33). The general printer driver 60 (Fig. 2) is configured to launch 110 (Fig. 3) a printing agent 58 (Fig. 2) to initiate the transmitting when the general printer driver 60 (Fig. 2) is selected as the destination printer (p.10, ln. 24-30). The method further includes receiving 114 (Fig. 3) the identification of the at least one available physical printer 16a,16b,16n,44 (Fig. 1) from the server 14 (Fig. 2) (p. 10, ln. 33 – p.11, ln. 2). The method additionally includes selecting 120 (Fig. 3) a single one of the identified physical printers 16a,16b,16n,44 (Fig. 1) to receive the print job (p.11, ln. 23-24). In addition, the method includes, after the selecting, downloading 124,132 (Fig. 3) from the server 14 (Fig. 2) a file 68' (Fig. 2) used to convert 128,134 (Fig. 3) print data into a format specific to the selected physical printer (p.11, ln.30-32; p.12, ln.18-20,26-30).

Independent claim 9 recites a client computer adapted for communication with a network, the network having a server and at least one physical printer available to receive a print job, the client computer having a utility for determining information regarding the at least one available physical printer (p.2, ln. 14-17). With reference to Figs. 2 and 3, the client computer includes means for calling 108 (Fig. 3) a general printer driver 60 (Fig. 2) directly from an application 56 (Fig. 2) executed by the client computer 12 (Fig. 2) (p.10, ln. 13-15). The structure corresponding to the calling means is a print menu 106 (Fig. 4) of a GUI 104 (Fig. 4) (p.9, ln.18-29). The general printer driver 60 (Fig. 2) is accessible as a destination printer 106 (Fig. 4) in the print menu 106 (Fig. 4) (p.10, ln. 8-9). The computer also includes means for transmitting 112 (Fig. 3) a query to the server 14 (Fig. 2) via a network 40 (Fig. 1) for an identification of the at least one available physical printer 16a,16b,16n,44 (Fig. 1) (p.10, ln.31-33). The structure corresponding to the transmitting means is the printing agent 58 (Fig. 2) (p.10, ln.24-30). The general printer driver 60 (Fig. 2) is configured to launch 110 (Fig. 3) the printing agent 58 (Fig. 2) to initiate the transmitting when the general printer driver 60 (Fig. 2) is selected as the destination printer (p.10, ln. 24-30). The computer further includes means for receiving 114 (Fig. 3) the identification of the at least one available physical printer 16a,16b,16n,44 (Fig. 1) from the server 14 (Fig. 2) (p. 10, ln. 33 – p.11, ln. 2). The structure corresponding to the receiving means is the printing agent 58 (Fig. 2) (p.10,

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ln. 31 – p.11, ln.2). The computer additionally includes means for selecting 120 (Fig. 3) a single one of the identified physical printers 16a,16b,16n,44 (Fig. 1) to receive the print job (p.11, ln. 23-24). The structure corresponding to the selecting means is the input interfaces 26 (Fig. 1) (p.4, ln.31 – p.5, ln.14). In addition, the computer includes means for, after the selecting, downloading from the server 14 (Fig. 2) a file 68' (Fig. 2) used to convert 128,134 (Fig. 3) print data into a format specific to the selected physical printer (p.11, ln.30-32; p.12, ln.18-20,26-30). The structure corresponding to the downloading means is the printing agent 58 (Fig. 2) (p.11, ln.30-32; p.12, ln. 26-30).

In some embodiments, the client computer 12 further includes means for overwriting 126 (Fig. 3) a generic printer description file 62 (Fig. 2) with the downloaded printer description file 68' (Fig. 2) (p.12, ln.8-10). The structure corresponding to the overwriting means is the printing agent 58 (Fig. 2) (p.12, ln.8-10). In some embodiments, the client computer 12 (Fig. 2) also includes means for converting 128,134 (Fig. 3) application specific data to be printed to printer specific data using the downloaded printer description file 68' (Fig. 2) (p.12, ln.18-20; p.12, ln.33 – p.13, ln.2). The structure corresponding to the overwriting means is the printer description file 68' (Fig. 2) (p.12, ln.18-20; p.12, ln.33 – p.13, ln.2).

Independent claim 15 recites a program embodied in a computer readable medium to determine information regarding at least one physical printer available to receive a print job from a client computer (p.2, ln. 22-24; p.13, ln.3-7). With reference to Figs. 2 and 3, the program includes general printer driver code 60 (Fig. 2) accessible as a destination printer in a print menu 106 (Fig. 4) of an application 56 (Fig. 2) executed by the client computer 12 (Fig. 2), the general printer driver code directly callable 108 (Fig. 3) by the application 56 (Fig. 2) when selected as the destination printer (p.10, ln. 13-15, 24-30). The program also includes printing agent code 58 (Fig. 2) launchable by the general printer driver code 60 (Fig. 2) (p.10, ln.24-30). The printing agent code 58 (Fig. 2) includes code that transmits 112 (Fig. 3) a query from the client computer 12 (Fig. 2) to a server 14 (Fig. 2) via a network 40 (Fig. 1) for an identification of the at least one available physical printer 16a,16b,16n,44 (Fig. 1) (p.10, ln.31-33). The printing agent code 58 (Fig. 2) also includes code that receives 114 (Fig. 3) an

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identification of the at least one available physical printer 16a,16b,16n,44 (Fig. 1) from the server 14 (Fig. 2) (p. 10, ln. 33 – p.11, ln. 2). The printing agent code 58 (Fig. 2) further includes code that, after selection of a single one of the identified physical printers 16a,16b,16n,44 (Fig. 1) to receive the print job, downloads 128,134 (Fig. 3) from the server 14 (Fig. 2) a file 68' (Fig. 2) used to convert print data into a format specific to the selected physical printer (p.11, ln.23-24,30-32; p.12, ln.18-20,26-30).

Independent claim 23 recites a program embodied in a computer readable medium for execution by a server to enable a client computer to determine information regarding at least one physical printer available to receive a print job from the client computer (p.2, ln. 30-33; p.13, ln.3-7). With reference to Figs. 2 and 3, the program includes code 66 (Fig. 2) that receives a query from the client computer 12 (Fig. 2) via a network 40 (Fig. 1) for an identification of the at least one available physical printer 16a,16b,16n,44 (Fig. 1) (p.10, ln.31-33). The query is initiated by an application 56 (Fig. 2) executed by the client computer 12 (Fig. 2) directly calling a general printer driver 60 (Fig. 2) that is accessible as a destination printer in a print menu 106 (Fig. 4) (p.10, ln. 13-15, 24-30). The general printer driver 60 (Fig. 2) is configured to launch 110 (Fig. 3) a printing agent 58 (Fig. 2) to initiate the query when the general printer driver 60 (Fig. 2) is selected as the destination printer (p.10, ln.24-30). The program also includes code that transmits 114 (Fig. 3) an identification of the at least one available physical printer 16a,16b,16n,44 (Fig. 1) to the client computer 12 (Fig. 2) (p.10, ln.33 – p.11, ln.8). The program further includes code that, after selection of a single one of the identified physical printers to receive the print job, transmits 124,132 (Fig. 3) a file 68' (Fig. 2) to the client computer 12 (Fig. 2) (p.11, ln.23-24,30-32; p.12, ln.26-30). The file 68' (Fig. 2) is used to convert 128,134 (Fig. 3) print data into a format specific to the selected physical printer (p.12, ln.18-20).

Independent claim 30 recites a method of determining information regarding at least one printer available to receive a print job from a client computer. With reference to Figs. 2 and 3, the method includes calling 108 (Fig. 3) a general printer driver 60 (Fig. 2) directly from an application 56 (Fig. 2) executed by the client computer 12 (Fig. 2) (p.10, ln. 13-15). The general printer driver 60 (Fig. 2) is accessible as a destination printer 106 (Fig. 4) in a

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print menu 106 (Fig. 4) (p.10, ln. 8-9). The method also includes transmitting 112 (Fig. 3) a query from the client computer 12 (Fig. 2) to a server 14 (Fig. 2) via a network 40 (Fig. 1) for an identification of the at least one available physical printer 16a,16b,16n,44 (Fig. 1) (p.10, ln.31-33). The application 56 (Fig. 2) is configured to launch a printing agent 58 (Fig. 2) to initiate the transmitting when the general printer driver 60 (Fig. 2) is selected as the destination printer (p.10, ln. 24-30). The method further includes receiving 114 (Fig. 3) the identification of the at least one available physical printer 16a,16b,16n,44 (Fig. 1) from the server 14 (p. 10, ln. 33 – p.11, ln. 2). Finally, the method includes downloading 124,132 (Fig. 3) a file 68' (Fig. 2) from the server 14 (Fig. 2) used to convert 128,134 (Fig. 3) print data into a format specific to a selected one of the at least one physical printer (p.11, ln.30-32; p.12, ln.18-20,26-30).

Independent claim 31 recites a method of determining information regarding at least one printer available to receive a print job from a client computer. With reference to Figs. 2 and 3, the method includes providing a general printer driver 60 (Fig. 2) on the client computer 12 (Fig. 2) accessible as a destination printer in a print menu 106 (Fig. 4) (p.10, ln.7-9). The method also includes selecting 102 (Fig. 3) the general printer driver 60 (Fig. 2) as the destination printer directly from an application 56 (Fig. 2) executed by the client computer 12 (Fig. 2) (p.9, ln.16-29). The method further includes, responsive to the selecting, launching 110 a printing agent 58 (Fig. 2) on the client computer 12 (Fig. 2) from the general printer driver 60 (Fig. 2) (p.10, ln. 24-30). The method additionally includes transmitting 112 (Fig. 3) a query from the printing agent 58 (Fig. 2) to a server 14 (Fig. 2) via a network 40 (Fig. 1) for an identification of the at least one available printer 16a,16b,16n,44 (Fig. 1) (p.10, ln.31-33). The method also includes receiving 114 (Fig. 3) at the client computer 12 (Fig. 2) an identification of the at least one available printer 16a,16b,16n,44 (Fig. 1) from the server 14 (Fig. 2) in response to the query (p. 10, ln. 33 – p.11, ln. 2). Furthermore, the method includes selecting 120 (Fig. 3), via the general printer driver 60 (Fig. 2), a single one of the at least one available printer 16a,16b,16n,44 (Fig. 1) to print the print job (p.11, ln. 23-24). In addition, the method includes, after selecting the printer, downloading 124,132 (Fig. 3) from the server 14 (Fig. 2) to the client computer 12 (Fig. 2) a

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file 68' (Fig. 2) configured to convert the print job into a format specific to the selected printer (p.11, ln.30-32; p.12, ln.18-20,26-30). Finally, the method includes printing 130,136 (Fig. 3) the print job on the selected printer (p.12, ln.21-22; p.13, ln.2).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claim 30 has been rejected under 35 USC §102(e), as being anticipated by U.S. patent application publication 2002/0163665 to Iwata et al. ("Iwata").

Claims 1-2, 6-7, 9, 13-16, 20-23, 25-27, and 31-36 have been rejected under 35 USC §103(a), as being unpatentable over U.S. patent application publication 2002/0163665 to Iwata et al. ("Iwata") in view of U.S. patent 5,692,111 to Marbry et al. ("Marbry").

Claims 3 and 17 have been rejected under 35 USC §103 (a), as being unpatentable over U.S. patent application publication 2002/0163665 to Iwata et al. ("Iwata") in view of U.S. patent 5,692,111 to Marbry et al. ("Marbry") and further in view of Official Notice.

Claims 4-5, 11-12, 18-19, and 24 have been rejected under 35 USC §103 (a), as being unpatentable over U.S. patent application publication 2002/0163665 to Iwata et al. ("Iwata") in view of U.S. patent 5,692,111 to Marbry et al. ("Marbry") and further in view of U.S. patent 5,580,177 to Gase et al. ("Gase").

Claim 30 stands or falls alone.

Claims 1-2, 6-7, 9, 13-16, 20-23, 25-27, and 32-34 stand or fall together.

Claim 35 stands or falls alone.

Claims 31 and 36 stand or fall together.

Claims 3 and 17 stand or fall together.

Claims 4-5, 11-12, 18-19, and 24 stand or fall together.

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VII. ARGUMENT

A. Claim 30 was improperly rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent application publication 2002/0163665 to Iwata et al. ("Iwata").

As to a rejection under §102, "[a]nticipation is established only when a single prior art reference discloses expressly or under the principles of inherencce, each and every element of the claimed invention." RCA Corp. v. Applied Digital Data Systems, Inc., (1984, CAFC) 221 U.S.P.O. 385. The standard for lack of novelty, that is for "anticipation," is one of strict identity. To anticipate a claim, a patent or a single prior art reference must contain all of the essential elements of the particular claims. Schroeder v. Owens-Corning Fiberglass Corp., 514 F.2d 901, 185 U.S.P.O. 723 (9th Cir. 1975); and Cool-Fin Elecs. Corp. v. International Elec. Research Corp., 491 F.2d 660, 180 U.S.P.O. 481 (9th Cir. 1974). The identical invention must be shown in as complete detail as is contained in the claim. Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim. In re Bond, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Appellants contend that claim 30 was improperly rejected because the single cited reference does not disclose all of the essential elements of the claims arranged as required by the claims and in as complete detail as in the claims.

1. The Iwata reference does not disclose all the limitations of Appellants' independent claim 30 in that the limitation of the application being configured to launch a printing agent to initiate the transmitting of a query from the client computer to a server for identification of an available printer when the general printer driver is selected as the destination printer is absent from the reference.

Independent claim 30 recites:

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"30. A method of determining information regarding at least one printer available to receive a print job from a client computer, comprising:

 calling a general printer driver directly from an application executed by the client computer;

transmitting a query from the client computer to a server via a network for an identification of the at least one available printer;

 receiving an identification of the at least one available printer from the server;
 downloading a file from the server used to convert print data into a format specific to a selected one of the at least one available printer; and

 wherein the general printer driver is accessible as a destination printer in a print menu, and wherein the application is configured to launch a printing agent to initiate the transmitting when the general printer driver is selected as the destination printer." (emphasis added)

The Iwata reference is directed to a "distributed printing control apparatus ... capable of printing multiple copies of the print data" (para. [0016]). The apparatus includes "a data allocation module that divides print data ... by page and specifies information representing pages allocated to multiple printers; and a data output control module that outputs the print data in a distributive manner to the multiple printers according to the information specified by the data allocation module" (para. [0016]).

a) There is no disclosure in the Iwata reference that (a) a query is transmitted from the client computer to a server via a network for an identification of the at least one available printer (b) when the General Printer Driver is selected as the destination printer.

With regard to this limitation, the Examiner states that "A query is inherently made to receive information" (Final Office Action, p.3). Appellants disagree.

First, the Iwata reference does not disclose the transmission of a query as specified by claim 30. Appellants disagree that such a query is inherently made to receive information for identifying at least one available printer in conjunction with the sequence of operations of Fig. 5 or Fig. 35, as asserted by the Examiner. To be inherent, it must exist as an essential constituent or characteristic. However, there are a number of alternative manners in which the at least one available printer could be identified. For example, the available physical printers could have been preconfigured such that no such query is required or performed. With regard to preconfiguration of available printers, the Examiner states that "even if the

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network printers have been preconfigured in an application, they were queried at least once so that they could be configured" (Advisory Action, p.3). Appellants disagree. For example, a known, fixed set of physical printers may be made available in a network system such that no query need ever be performed.

Second, even assuming, arguendo, and which Appellants do not concede, that the network printers were queried once, the totality of claim 30 recites that the query is performed when the general printer driver is selected as the destination printer. It is not inherent that any one-time query, as postulated by the Examiner, must be performed at the time when the general printer driver is selected as the destination printer. Since the general printer driver can be selected as the destination printer for multiple print jobs at various times when the user is executing the application, the one-time query to predetermine the available printers would necessarily have been performed at some different, earlier time.

b) There is no disclosure in the Iwata reference that a Printing Agent - different from the Application and the General Printer Driver - is launched to initiate the transmitting of a query for identification of an available printer when the General Printer Driver is selected as the destination printer.

Claim 30 recites separate elements of an application, a general printer driver, a file downloaded from a server, and a printing agent. In Fig. 2, the Iwata reference discloses application program 100 (i.e. application), and virtual printer driver 110 (i.e. general printer driver). With regard to the printing agent that is launched to initiate the transmitting of a query for identification of an available printer when the general printer driver is selected as the destination printer, "[t]he Examiner points to Fig. 35 as a printing agent" (Advisory Action, p.2).

Fig. 35 illustrates a user interface of a Distributed Printing Properties window. "This dialog box 'Distributed Printing Properties' corresponds to the user interface 116" (para. [0154]). "In the virtual printer driver 110, the properties setting module 113 activates a user interface 116 to set and store various pieces of information required for printing" (para. [0141]). Thus the user interface 116 is not a separate element from the virtual printer driver

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110, but rather part of the virtual printer driver 110, as is clearly illustrated in Fig. 3.

Nor does the Distributed Printing Properties window CD12 initiate the transmitting of a query for identification of an available printer when the virtual printer driver 110 is selected as the destination printer. With regard to available printers, the Iwata reference teaches merely that “[i]n response to setting a selected group name in the ‘Group Name’ data input box id111, the names of all the printers belonging to the selected group are shown in the ‘Printers’ display box id113. In the initial state, the check boxes cbx provided before the respective printer names are all checked. When the operator desires to prohibit output of the print data to a certain printer because of out-of-paper, failure, or any other reason, the operator releases the check in the corresponding check box cbx to exclude the printer from the output resource of the print data” (para. [0295]). There is no disclosure that Distributed Printing Properties window knows anything about the printer status. Were the Distributed Printing Properties window capable of knowing the printer status, it could automatically deselect a printer problem, or at least inform the user through a status message or another dialog box of the problem with a particular printer. Instead, however, the Iwata reference discloses that it is left to the user to be independently aware of the inability of a printer in the group to print, so that the user can then manually deselect that printer in check box cbx.

In addition, there is no disclosure that the Distributed Printing Properties window of Fig. 35 transmits a query for identification of an available printer for similar reasons as some of those explained heretofore. In particular, there is no disclosure in the Iwata reference that a query is inherently made to receive information for identifying at least one available printer. To be inherent, it must exist as an essential constituent or characteristic. However, there are a number of alternative manners in which the at least one available printer could be identified. For example, the available physical printers could have been preconfigured such that no such query is required or performed. With regard to preconfiguration of available printers, the Examiner states that “even if the network printers have been preconfigured in an application, they were queried at least once so that they could be configured” (Advisory Action, p.3). Appellants disagree. For example, a known, fixed set of physical printers may be made available in a network system such that no query need ever be performed. Furthermore, even

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assuming, arguendo, and which Appellants do not concede, that the network printers were queried once, the totality of claim 30 recites that the query is performed when the general printer driver is selected as the destination printer. It is not inherent that any one-time query, as postulated by the Examiner, must be performed at the time when the general printer driver is selected as the destination printer. Since the general printer driver can be selected as the destination printer for multiple print jobs at various times when the user is executing the application, the one-time query to predetermine the available printers would necessarily have been performed at some different, earlier time.

c) There is no disclosure in the Iwata reference that the Application is configured to launch the Printing Agent.

The Examiner contends that the Iwata reference discloses that the application 100 is configured to launch the printing agent (i.e. the Distributed Printing Properties window of Fig. 35):

"see in P[0234] that the Distributed printing properties is provided as an user interface, which is part of an appropriate application program. Thus, it can still be reasonably interpreted that the application program calls the printing agent" (Final Office Action, p.2; emphasis added).

First, Appellants disagree that the Distributed Printing Properties window is generated by, or "is part of", the application program 100. Instead, the Iwata reference discloses that the Distributed Printing Properties window is the user interface 116 of the virtual printer driver 110, not the application program 100 (Fig. 3):

"The operator double clicks the icon IC4 'Distributed Printing' corresponding to the virtual printer driver 110 on the 'Printer' window WN1 to open a window of the virtual printer driver 110 and clicks 'Printer' and 'Properties' in the window. This series of operations opens a dialog box 'Distributed Printing Properties' for setting various pieces of information with regard to the virtual printer. The operator can input the settings of the various pieces of information in the dialog box 'Distributed Printing Properties' through the operations of the mouse 20 and the keyboard 18. This dialog box 'Distributed Printing Properties' corresponds to the user interface 116 mentioned previously." (para. [0154]; emphasis added)

Furthermore, the Iwata reference teaches that the user is interacting with the virtual printer driver 110 at that point, not with the application program 100:

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"[0260] The CPU 30 executes a 'Print' command provided in the application program and thereby outputs a print command for distributed printing (step S920). FIG. 27 illustrates a 'Print' dialog box WN16 open on the CRT display 12 in response to execution of the 'Print' command on the application program 100. ... The print command for distributed printing is output from the application program 100 via the operating system to the virtual printer driver 110 in response to a click of an 'OK' button id152 with the mouse 20, while a series of letters 'Distributed Printing', which corresponds to the 'Distributed Printing' icon IC4 discussed previously with FIG. 5, is selectively input in the 'Printer Name' data input box id151. A click of a 'Properties' button id153 in the 'Print' dialog box WN16 shifts the processing to a distribution information setting routine executed in the virtual printer driver 110. The process opens the 'Distributed Printing Properties' dialog box WN12 on the CRT display 12 and reads input data from the keyboard 18 and the mouse 20, so as to set various pieces of information regarding the distributed printing." (para. [0260]; emphasis added)

Thus, any actions regarding distributed printing performed as a result of the user interacting with the Distributed Printing Properties window are performed by the virtual printer driver 110, not the application program 100.

Second, in the Advisory Action, the Examiner states that "the only reasonable interpretation that the Examiner can take is that the application launches the printing agent indirectly through the virtual print driver, which still indicates that the virtual print driver is the one launching the printing agent" (Advisory Action, p.2). Appellants disagree. The language of claim 30 clearly recites that "the application is configured to launch a printing agent". Furthermore, the language of that claim 30 is different from, for example, claim 1, in which it is recited that "the general printer driver is configured to launch a printing agent".

Also in the Advisory Action, the Examiner further states that "If this interpretation is not regarded as reasonable, then the claim that the application program launches the printing agent would consist of new matter and would be subject to a 112 rejection" (Advisory Action, p.2). Appellants disagree. Appellants' specification teaches:

"Next, in box 110 and identified in FIG. 2 as event C, the virtual driver 60 launches the printing agent 58. Therefore, the virtual driver 60 is used as a means to launch the printing agent 58. This arrangement is used to bypass algorithms contained in many operating systems 54 that may preclude the launching of the printing agent 58 directly from the application 56, especially after the print command is selected. However, in an alternative embodiment of the present invention, the printing agent 58 is launched directly by the user." (Specification, p.10, lines 24-30; emphasis added)

Thus, in one embodiment the printing agent is launched by the application indirectly

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through the general printing driver. However, in another embodiment, in which the operating system does not include algorithms that preclude the launching of the printing agent directly from the application, the printing agent is launched directly from the application as a result of the user's directions to the application (i.e. selecting the print command). Therefore, there is no basis for a rejection under 35 U.S.C. §112.

As discussed heretofore, the Examiner has failed to establish a *prima facie* case of anticipation in that the above-discussed essential elements, arranged as required by the claim and recited in as complete detail as in the claim, are absent from the reference. Therefore, the rejection is improper at least for that reason and should be overruled.

B. Claims 1-2, 6-7, 9, 13-16, 20-23, 25-27, and 32-34 were improperly rejected under 35 U.S.C. §103(a), as being unpatentable over U.S. Patent Application Publication No. 2002/0163665 to Iwata et al. ("Iwata") in view of U.S. Patent No. 5,692,111 to Marbry et al. ("Marbry").

As to a rejection under §103(a), the U.S. Patent and Trademark Office ("USPTO") has the burden under §103 to establish a *prima facie* case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). The Manual of Patent Examining Procedure (MPEP) section 2143 discusses the requirements of a *prima facie* case for obviousness. That section provides as follows:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make

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the claimed combination and reasonable expectation of success must be found in the prior art, and not based on applicant's disclosure.

Appellants contend that claims 1-2, 6-7, 9, 13-16, 20-23, 25-27, and 32-34 were improperly rejected because (1) the applied references, alone or in combination, do not teach or suggest all of Appellants' claim limitations; (2) there is no articulated reason with some rational underpinning to modify or combine reference teachings; and (3) there is no reasonable expectation of success in combining the references. Such could be possible only in hindsight and in light of Appellants' teachings.

1. The cited references, alone or in combination, do not teach or suggest all the limitations of Appellants' independent claims 1, 9, 15, and 23 in that the limitation of the general printer driver being configured to launch a printing agent to initiate the transmitting of a query from the client computer to a server for identification of an available printer when the general printer driver is selected as the destination printer is absent from the references.

Representative independent claim 1 recites:

"1. A method of determining information regarding at least one physical printer available to receive a print job from a client computer, comprising:
calling a general printer driver directly from an application executed by the client computer;
transmitting a query from the client computer to a server via a network for an identification of the at least one available physical printer;
receiving the identification of the at least one available physical printer from the server;
selecting a single one of the identified physical printers to receive the print job;
after the selecting, downloading from the server a file used to convert print data into a format specific to the selected physical printer; and
wherein the general printer driver is accessible as a destination printer in a print menu, and wherein the general printer driver is configured to launch a printing agent to initiate the transmitting when the general printer driver is selected as the destination printer." (emphasis added)

- a) There is no teaching or suggestion in the combination of the Iwata and

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Marbry references that (a) a query is transmitted from the client computer to a server via a network for an identification of the at least one available printer (b) when the General Printer Driver is selected as the destination printer.

With regard to this limitation, the Examiner states that, in the Iwata reference, “[a] query is inherently made to receive information” (Final Office Action, p.4). Appellants disagree.

First, the Iwata reference does not disclose the transmission of a query as specified by claim 1. Appellants disagree that such a query is inherently made to receive information for identifying at least one available printer in conjunction with the sequence of operations of Fig. 5 or Fig. 35, as asserted by the Examiner. To be inherent, it must exist as an essential constituent or characteristic. However, there are a number of alternative manners in which the at least one available printer could be identified. For example, the available physical printers could have been preconfigured such that no such query is required or performed. With regard to preconfiguration of available printers, the Examiner states that “even if the network printers have been preconfigured in an application, they were queried at least once so that they could be configured” (Advisory Action, p.3). Appellants disagree. For example, a known, fixed set of physical printers may be made available in a network system such that no query need ever be performed.

Second, even assuming, arguendo, and which Appellants do not concede, that the network printers were queried once, the totality of claim 1 recites that the query is performed when the general printer driver is selected as the destination printer. It is not inherent that any one-time query, as postulated by the Examiner, must be performed at the time when the general printer driver is selected as the destination printer. Since the general printer driver can be selected as the destination printer for multiple print jobs at various times when the user is executing the application, the one-time query to predetermine the available printers would necessarily have been performed at some different, earlier time.

The Examiner does not cite the Marbry reference as teaching these limitations, and Appellants believe the Marbry reference teaches no such limitations. Nor does the combination of the Iwata and Marbry references suggest such limitations. Therefore, the

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Examiner has failed to establish a *prima facie* case of obviousness at least on these grounds, and the rejection is improper at least for this reason and should be overruled.

b) There is no teaching or suggestion in the combination of the Iwata and Marbry references that a Printing Agent - different from the Application and the General Printer Driver - is launched to initiate the transmitting of a query for identification of an available printer when the General Printer Driver is selected as the destination printer.

Claim 1 recites separate elements of an application, a general printer driver, and a printing agent. In Fig. 2, the Iwata reference discloses application program 100 (i.e. application); and virtual printer driver 110 (i.e. general printer driver). With regard to the printing agent that is launched to initiate the transmitting of a query for identification of an available printer when the general printer driver is selected as the destination printer, “[t]he Examiner points to Fig. 35 as a printing agent” (Advisory Action, p.2).

Fig. 35 of the Iwata reference illustrates a user interface of a Distributed Printing Properties window. “This dialog box ‘Distributed Printing Properties’ corresponds to the user interface 116” (para. [0154]). “In the virtual printer driver 110, the properties setting module 113 activates a user interface 116 to set and store various pieces of information required for printing” (para. [0141]). Thus the user interface 116 is not a separate element from the virtual printer driver 110, but rather part of the virtual printer driver 110, as is clearly illustrated in Fig. 3.

Nor does the Distributed Printing Properties window CD12 initiate the transmitting of a query for identification of an available printer when the virtual printer driver 110 is selected as the destination printer. With regard to available printers, the Iwata reference teaches merely that “[i]n response to setting a selected group name in the ‘Group Name’ data input box id111, the names of all the printers belonging to the selected group are shown in the ‘Printers’ display box id113. In the initial state, the check boxes cbx provided before the respective printer names are all checked. When the operator desires to prohibit output of the print data to a certain printer because of out-of-paper, failure, or any other reason, the

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operator releases the check in the corresponding check box cbx to exclude the printer from the output resource of the print data" (para. [0295]). There is no disclosure that Distributed Printing Properties window knows anything about the printer status. Were the Distributed Printing Properties window capable of knowing the printer status, it could automatically deselect a printer problem, or at least inform the user through a status message or another dialog box of the problem with a particular printer. Instead, however, the Iwata reference discloses that it is left to the user to be independently aware of the inability of a printer in the group to print, so that the user can then manually deselect that printer in check box cbx.

In addition, there is no disclosure that the Distributed Printing Properties window of Fig. 35 transmits a query for identification of an available printer for similar reasons as some of those explained heretofore with regard to Fig. 5. In particular, there is no disclosure in the Iwata reference that a query is inherently made to receive information for identifying at least one available printer. To be inherent, it must exist as an essential constituent or characteristic. However, there are a number of alternative manners in which the at least one available printer could be identified. For example, the available physical printers could have been preconfigured such that no such query is required or performed. With regard to preconfiguration of available printers, the Examiner states that "even if the network printers have been preconfigured in an application, they were queried at least once so that they could be configured" (Advisory Action, p.3). Appellants disagree. For example, a known, fixed set of physical printers may be made available in a network system such that no query need ever be performed. Furthermore, even assuming, arguendo, and which Appellants do not concede, that the network printers were queried once, the totality of claim 30 recites that the query is performed when the general printer driver is selected as the destination printer. It is not inherent that any one-time query, as postulated by the Examiner, must be performed at the time when the general printer driver is selected as the destination printer. Since the general printer driver can be selected as the destination printer for multiple print jobs at various times when the user is executing the application, the one-time query to predetermine the available printers would necessarily have been performed at some different, earlier time.

The Examiner does not cite the Marbry reference as teaching these limitations, and

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Appellants believe the Marbry reference teaches no such limitations. Nor does the combination of the Iwata and Marbry references suggest such limitations. Therefore, the Examiner has failed to establish a *prima facie* case of obviousness and the rejection under 103(a) should be overruled at least for this reason.

2. There is no articulated reason with some rational underpinning to modify or combine reference teachings in that there is no need to combine in the teachings of the Marbry reference to allow users in the Iwata reference to print to a single printer instead of a plurality of printers.

In order to establish a *prima facie* case of obviousness, there must be an articulated reason with some rational underpinning that would have prompted a person of ordinary skill in the relevant field to combine the prior art elements in the manner claimed. *In Re Kahn, 441 F.3d, 977, 988 (CA Fed. 2006)*. A patent composed of several elements is not proved obvious merely by demonstrating that each element was, independently, known in the prior art.

The Examiner states that the Iwata and Marbry references can be combined together in order “to allow users to print to a single printer instead of a plurality of printers like in the Iwata reference” (Final Office Action, p.5).

Appellants disagree. The Iwata reference, standing alone, discloses that users can print to a single printer instead of a plurality of printers without requiring any additional teachings. The Printer window WN1 (Fig. 5), in addition to the “Distributed Printing” icon IC4 that corresponds to virtual printer driver 110, also contains “icons IC1, IC2, and IC3 representing the real printer drivers 130, 140, and 150 individually provided for the respective types of the printers 60, 70, and 80.” If the user desired to print on a single one of printers 60,70,80, then in the Printer Name data input box id21 of Printer dialog box WN3 the user would merely select “LP-100” (for printer 60), “LP-200” (for printer 70), or “LP-300” (for printer 80), instead of selecting “Distributed Printing” for the virtual printer driver.

Therefore, the reason provided by the Examiner for combining the teachings of the Iwata and Marbry lacks the rational underpinning required for validly combining these references. Consequently, this rationale impermissibly uses the Appellants’ disclosure as a

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blueprint or in hindsight for the rejection. Because the Examiner has not provided an articulated reason with some rational underpinning to combine the prior art elements in the manner claimed, the Examiner has failed to establish a *prima facie* case of obviousness and the rejection under 103(a) should be overruled at least for this reason.

3. There is no reasonable expectation of success in modifying the reference or combining reference teachings in that the proposed combination of the Iwata and Marbry references would produce a seemingly inoperative device that could not properly form the intermediate print file.

With regard to obviousness, it has been held that:

"If references taken in combination would produce a 'seemingly inoperative device', we have held that such references teach away from the combination and thus cannot serve as predicates for a *prima facie* case of obviousness" *McGinley v. Franklin Sports Inc.*, 60 USPQ2d 1001, 101 (Fed. Cir. 2001).

Here, combining the Iwata and Marbry references would result in an inoperative device. As a result, either or both of these references teach away from combination with the other.

Claim 1 recites that a file used to convert print data into a format specific to a selected physical printer is downloaded from a server after a single selected physical printer is identified to receive the print job. With regard to the operation of the Iwata reference, the Examiner identifies the virtual printer driver 110 of the reference to be the general printer driver recited in claim 1 (Final Office Action, p.3). The Examiner further states that "Figs. 16 item S500 and P[315] discloses that the distributed printing utility does convert data to a specific format for a printer" (Final Office Action, p.4). Accordingly, the distributed printing utility 120 of the Iwata reference corresponds to the file recited in claim 1 that is downloaded from the server. However, the distributed printing utility 120 also provides performance information about printers 60, 70, 80 to module 114 of the virtual printer driver 110 (para. [0138]-[0140]). This performance information is required in order to identify which physical printer or printers among the group of available printers should receive the print job (para. [0136]-[0138]), and in order for the application program 100 to "convert the generated video data into print data adequate for the printer (the virtual printer) based on the input

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performance information" (para. [0142]). Since it would not be possible for the distributed printing utility 120 to provide the performance information about printers 60, 70, 80 until the distributed printing utility 120 has already been downloaded into, and is being executed by, the client computer, the Iwata reference teaches that the downloading of the distributed printing utility 120 is performed before selecting the identified physical printer(s) to receive the print job, not after the selecting as required by claim 1.

The Examiner cites the Marbry reference as teaching (in Fig. 3, and at col. 3, lines 44-65) the limitations of selecting a single one of the identified physical printers to receive the print job, and, after the selecting, downloading from the server a file used to convert print data into a format specific to the selected physical printer (Final Office Action, p.4-5). However, combining such features of the Marbry reference with the Iwata reference would result in an inoperative device, because the Iwata reference requires that the downloaded server file (distributed printing utility 120) already be in place before the physical printer(s) that will receive the print job are selected. If the downloaded server file were not in place before the physical printer or printers to receive the print job are selected, the Iwata system would be inoperative because the performance information about printers 60,70,80 could not be provided to the virtual printer driver 110. Without knowing the performance information, the virtual printer driver 110 cannot properly form the intermediate print file (para. [0201]-[0203]). Therefore, the combined references would result in a seemingly inoperative device, and there is no reasonable expectation of success in modifying the reference or combining reference teachings.

Because the combination proposed by the Examiner would result in an inoperative device, the Examiner has failed to establish a *prima facie* case of obviousness and the rejection under 103(a) should be overruled at least for this reason. Furthermore, because their combination would result in an inoperative device, the Iwata and Marbry references teach away from combination with each other. Any suggestion or motivation to modify the Iwata reference in the manner necessary to render claim 1 obvious could be possible only in hindsight and in light of Appellants' own teachings.

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The rejection of independent claims 9, 15, and 23, and dependent claims 2, 6-7, 13-14, 16, 20-22, 25-27, and 32-34, should be overruled at least for the same reasons as explained heretofore for independent claim 1.

C. Claim 35 was improperly rejected under 35 U.S.C. §103(a), as being unpatentable over U.S. Patent Application Publication No. 2002/0163665 to Iwata et al. ("Iwata") in view of U.S. Patent No. 5,692,111 to Marbry et al. ("Marbry").

1. The rejection of dependent claim 35 is improper for the same reasons that render the rejection of its base claim 30 improper.

"A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers." (35 U.S.C. §112, paragraph 4.)

Claim 35 depends from base claim 30, which was rejected under 35 U.S.C. 102(c) based on the Iwata reference. Appellants have argued heretofore the reasons why the rejection of base claim 30 is improper. Because the rejection of base claim 30 is improper, the rejection of dependent claim 35 is also improper for at least the same reasons.

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D. Claims 31 and 36 were improperly rejected under 35 U.S.C. §103(a), as being unpatentable over U.S. Patent Application Publication No. 2002/0163665 to Iwata et al. ("Iwata") in view of U.S. Patent No. 5,692,111 to Marbry et al. ("Marbry").

1. The cited references, alone or in combination, do not teach or suggest all the limitations of Appellants' independent claim 31 in that the limitations of launching a printing agent responsive to selecting a general printer driver as the destination printer and transmitting a query from the printing agent to a server for identification of an available printer is absent from the references.

Independent claim 31 recites:

"31. (Previously presented) A method of determining information regarding at least one printer available to receive a print job from a client computer, comprising:
 providing a general printer driver on the client computer accessible as a destination printer in a print menu;
 selecting the general printer driver as the destination printer directly from an application executed by the client computer;
 responsive to the selecting, launching a printing agent on the client computer from the general printer driver;
 transmitting a query from the printing agent to a server via a network for an identification of the at least one available printer;
 receiving at the client computer an identification of the at least one available printer from the server in response to the query;
 selecting, via the general printer driver, a single one of the at least one available printer to print the print job; and
 after selecting the printer, downloading from the server to the client computer a file configured to convert the print job into a format specific to the selected printer; and
 printing the print job on the selected printer." (emphasis added)

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a) There is no teaching or suggestion in the combination of the Iwata and Marbry references that (a) a query is transmitted from the printing agent to a server via a network for an identification of the at least one available printer (b) responsive to the selection of the General Printer Driver as the destination printer and launching of the printing agent.

With regard to this limitation, the Examiner states that Fig. 35 of the Iwata reference is the printing agent (Advisory Action, p.2), and that these limitation are taught by Fig. 35, item id113 of the Iwata reference (Final Office Action, p.7). Appellants disagree.

The Iwata reference discloses that "[t]he 'Printers' display box id113 shows the names of the printers belonging to the currently selected group in the 'Group Name' data input box id111" (para. [0239]). "The 'Group Name' data input box id131 is used to input the name of the selected group of printers. ...The 'Printers Belonging to' display box id133 shows printers belonging to the selected group. The 'Printers Not Belonging to' display box id134 shows printers that are not included in the selected group among a large number of preset printer names" (para. [0243]). "The operator selects a desired one out of the printer names shown in the 'Printers Not Belonging to' display box id134 and clicks an 'Add' button id135. The selected printer name is then transferred to the 'Printers Belonging to' display box id133" (para. [0244]).

First, nowhere does the Iwata reference teach or suggest how the set of printers that are listed in boxes id133,id134 are identified. Appellants contend, as previously argued, that it is not inherent that a query be made to receive information for identifying at least one available printer. There are a number of manners in which the at least one available printer could be identified without performing a query. For example, the available physical printers could have been preconfigured such that no such query is required or performed. As another example, a known, fixed set of physical printers may be made available in a network system such that no query need ever be performed.

Second, even assuming, arguendo, and which Appellants do not concede, that a query is performed, there is no teaching or suggestion that the query is performed responsive to the selection of the General Printer Driver as the destination printer and launching of the printing

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agent, as recited in claim 31. Since the general printer driver can be selected as the destination printer for multiple print jobs at various times when the user is executing the application, the one-time query to predetermine the available printers would necessarily have been performed at some different, earlier time.

The Examiner does not cite the Marbry reference as teaching these limitations, and Appellants believe the Marbry reference teaches no such limitations. Nor does the combination of the Iwata and Marbry references suggest such limitations. Therefore, the Examiner has failed to establish a *prima facie* case of obviousness at least on these grounds, and the rejection is improper at least for this reason and should be overruled.

b) There is no teaching or suggestion in the combination of the Iwata and Marbry references that a Printing Agent - different from the Application and the General Printer Driver - is launched responsive to the General Printer Driver being selected as the destination printer, and then transmits to a server a query for identification of an available printer.

Claim 31 recites separate elements of an application, a general printer driver, and a printing agent. In Fig. 2, the Iwata reference discloses application program 100 (i.e. application), and virtual printer driver 110 (i.e. general printer driver). With regard to the printing agent that is launched responsive to the general printer driver being selected as the destination printer and then transmits a query for identification of an available printer, “[t]he Examiner points to Fig. 35 as a printing agent” (Advisory Action, p.2).

Fig. 35 of the Iwata reference illustrates a user interface of a Distributed Printing Properties window. “This dialog box ‘Distributed Printing Properties’ corresponds to the user interface 116” (para. [0154]). “In the virtual printer driver 110, the properties setting module 113 activates a user interface 116 to set and store various pieces of information required for printing” (para. [0141]). Thus the user interface 116 is not a separate element from the virtual printer driver 110, but rather part of the virtual printer driver 110, as is clearly illustrated in Fig. 3.

Nor does the Distributed Printing Properties window CD12 initiate the transmitting of

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a query for identification of an available printer when the virtual printer driver 110 is selected as the destination printer. With regard to available printers, the Iwata reference teaches merely that “[i]n response to setting a selected group name in the ‘Group Name’ data input box id111, the names of all the printers belonging to the selected group are shown in the ‘Printers’ display box id113. In the initial state, the check boxes cbx provided before the respective printer names are all checked. When the operator desires to prohibit output of the print data to a certain printer because of out-of-paper, failure, or any other reason, the operator releases the check in the corresponding check box cbx to exclude the printer from the output resource of the print data” (para. [0295]). There is no disclosure that Distributed Printing Properties window knows anything about the printer status. Were the Distributed Printing Properties window capable of knowing the printer status, it could automatically deselect a printer problem, or at least inform the user through a status message or another dialog box of the problem with a particular printer. Instead, however, the Iwata reference discloses that it is left to the user to be independently aware of the inability of a printer in the group to print, so that the user can then manually deselect that printer in check box cbx.

In addition, as argued above, there is no disclosure that the Distributed Printing Properties window of Fig. 35 transmits a query for identification of an available printer.

The Examiner does not cite the Marbry reference as teaching these limitations, and Appellants believe the Marbry reference teaches no such limitations. Nor does the combination of the Iwata and Marbry references suggest such limitations. Therefore, the Examiner has failed to establish a *prima facie* case of obviousness and the rejection under 103(a) should be overruled at least for this reason.

2. The cited references, alone or in combination, do not teach or suggest all the limitations of Appellants' independent claim 31 in that the limitations of after selecting the printer, downloading from the server to the client computer a file configured to convert the print job into a format specific to the selected printer are absent from the references.

Claim 31 recites that after selecting the printer on which it is desired to print the print

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job, a file configured to convert the print job into a format specific to a single selected printer is downloaded from the server to the client computer.

In the rejection, the Examiner identifies the distributed printing utility 120 of the reference as the element of the Iwata reference that corresponds to the file recited in claim 31 that is downloaded from the server (Final Office Action, p.7). The Examiner further states that "Figs. 16 item S500 and P[315] discloses that the distributed printing utility does convert data to a specific format for a printer" (Final Office Action, p.7). However, the distributed printing utility 120 also provides performance information about printers 60, 70, 80 to module 114 of the virtual printer driver 110 (para. [0138]-[0140]). This performance information is required in order to identify which physical printer or printers among the group of available printers should receive the print job (para. [0136]-[0138]), and in order for the application program 100 to "convert the generated video data into print data adequate for the printer (the virtual printer) based on the input performance information" (para. [0142]). Since it would not be possible for the distributed printing utility 120 to provide the performance information about printers 60, 70, 80 until the distributed printing utility 120 has already been downloaded into, and is being executed by, the client computer, the Iwata reference teaches that any downloading of the distributed printing utility 120 must necessarily have been performed before selecting the identified physical printer(s) to receive the print job, not after the selecting as required by claim 31.

The Examiner does not cite the Marbry reference as teaching these limitations, and Appellants believe the Marbry reference teaches no such limitations. Nor does the combination of the Iwata and Marbry references suggest such limitations. Therefore, the Examiner has failed to establish a *prima facie* case of obviousness at least on these grounds, and the rejection is improper at least for this reason and should be overruled.

3. The cited references, alone or in combination, do not teach or suggest all the limitations of Appellants' independent claim 31 in that the limitations of selecting a single one of the at least one available printer to print the print job and, after selecting the printer, downloading a file to convert the print

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job into a format specific to the single selected printer are absent from the references.

Claim 31 recites that after selecting the printer on which it is desired to print the print job, a file configured to convert the print job into a format specific to a single selected printer is downloaded from the server to the client computer.

Conversely, the Iwata reference is directed to distributing the print job among multiple printers. "Output of the print data to multiple printers in a distributive manner desirably shortens the total time required for printing" (para. [0002]). "The present invention is directed to a first distributed printing control apparatus, which includes: a data allocation module that divides print data, which is an object to be printed, by page and specifies information representing pages allocated to multiple printers; and a data output control module that outputs the print data in a distributive manner to the multiple printers according to the information specified by the data allocation module" (para. [0016]). Thus if printing on only a single printer were desired by the user, it would be done most efficiently, without the extensive overhead of the distributive mechanisms, by merely selecting the real printer driver 130,140,150 (Fig. 2) to perform the printing, rather than the virtual printer driver 110.

The Examiner states that "the Iwata reference identifies a plurality of printers 60,70,80 to query prior to downloading of the distributed printing utility 120. Among them, one is chosen" (Advisory Action, p.3). Appellants disagree. First, as explained heretofore, there is no explicit or inherent teaching or suggestion in the Iwata reference that the plurality of printers is queried. In addition, there is no explicit or inherent teaching or suggestion in the Iwata reference that the distributed printing utility 120 is downloaded after selecting a printer to print the print job because, as explained heretofore, the distributed printing utility 120 must necessarily be in place to provide the performance information before selecting the identified physical printer to receive the print job.

The Examiner does not cite the Marbry reference as teaching these limitations, and Appellants believe the Marbry reference teaches no such limitations. Nor does the combination of the Iwata and Marbry references suggest such limitations. Therefore, the Examiner has failed to establish a prima facie case of obviousness at least on these grounds,

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and the rejection is improper at least for this reason and should be overruled.

4. There is no articulated reason with some rational underpinning to modify or combine reference teachings in that there is no need to combine in the teachings of the Marbry reference to allow users in the Iwata reference to print to a single printer instead of a plurality of printers.

For similar reasons as explained heretofore with reference to claim 1, the reason provided by the Examiner for combining the teachings of the Iwata and Marbry lacks the rational underpinning required for validly combining these references. Consequently, this rationale impermissibly uses the Appellants' disclosure as a blueprint or in hindsight for the rejection. Because the Examiner has not provided an articulated reason with some rational underpinning to combine the prior art elements in the manner claimed, the Examiner has failed to establish a *prima facie* case of obviousness and the rejection under 103(a) should be overruled at least for this reason.

5. There is no reasonable expectation of success in modifying the reference or combining reference teachings in that the proposed combination of the Iwata and Marbry references would produce a seemingly inoperative device that could not properly form the intermediate print file.

Because the combination proposed by the Examiner would result in an inoperative device for similar reasons as explained heretofore with reference to claim 1, the Examiner has failed to establish a *prima facie* case of obviousness and the rejection under 103(a) of claim 31 should be overruled at least for this reason. Furthermore, because their combination would result in an inoperative device, the Iwata and Marbry references teach away from combination with each other. Any suggestion or motivation to modify the Iwata reference in the manner necessary to render claim 31 obvious could be possible only in hindsight and in light of Appellants' own teachings.

The rejection of dependent claims 36, should be overruled at least for the same reasons as explained heretofore for independent claim 31.

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E. Claims 3 and 17 have been rejected under 35 U.S.C. §103(a), as being unpatentable over U.S. Patent Application Publication No. 2002/0163665 to Iwata et al. ("Iwata") in view of U.S. Patent No. 5,692,111 to Marbry et al. ("Marbry") and further in view of Official Notice.

1. The rejection of dependent claims 3 and 17 is improper for the same reasons that render the rejection of their base claims 1 and 15 improper.

"A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers." (35 U.S.C. §112, paragraph 4.)

Claim 3 depends indirectly from base claim 1, and claim 17 depends indirectly from base claim 15, which were rejected under 35 U.S.C. 103(a) based on the Iwata and Marbry references. Appellants have argued heretofore the reasons why the rejection of base claim 1 is improper. Base claim 15 stands or falls with claim 1. Because the rejection of base claim 1 is improper, the rejection of dependent claims 3 and 17 is also improper for at least the same reasons.

F. Claims 4-5, 11-12, 18-19, and 24 have been rejected under 35 U.S.C. §103(a), as being unpatentable over U.S. Patent Application Publication No. 2002/0163665 to Iwata et al. ("Iwata") in view of U.S. Patent No. 5,692,111 to Marbry et al. ("Marbry") and further in view of U.S. Patent No. 5,580,177 to Gase et al. ("Gase").

1. The rejection of dependent claims 4-5, 11-12, 18-19, and 24 is improper for the same reasons that render the rejection of their base claims 1, 9, 15, and 23 improper.

"A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers." (35 U.S.C. §112, paragraph 4.)

Claims 4-5, 11-12, 18-19, and 24 depend directly or indirectly from one of base claims 1, 9, 15, and 23, which were rejected under 35 U.S.C. 103(a) based on the Iwata and

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Marbry references, and against which the Gase reference has not been cited. Appellants have argued heretofore the reasons why the rejection of base claim 1 is improper. Base claims 9, 15, and 23 stand or fall with claim 1. Because the rejection of base claim 1 is improper, the rejection of dependent claims 4-5, 11-12, 18-19, and 24 is also improper for at least the same reasons.

2. There is no articulated reason with some rational underpinning to modify or combine reference teachings of the Gase reference with the Iwata and Marbry references.

The Examiner states that the Gase reference can be combined with the Iwata and Marbry references in order “to have the most current driver available for compatibility and efficiency reasons” (Final Office Action, p.10).

Appellants disagree. The Examiner states that the Gase reference “has the ability to overwrite a printer driver with a newer one ... The printer driver would read on as a printer description file.” (Final Office Action, p.9-10; emphasis added). However, Appellants’ invention is not directed to overwriting an older version of a printer description file 68’ for printer A with a newer version of the printer description file 68’ for the same printer A. Instead, Appellants’ invention is directed to overwriting the printer description file 68’ for printer A with a different printer description file 68’ for printer B.

Therefore, the reason provided by the Examiner for combining the teachings of the Gase reference with the Iwata and Marbry references lacks the rational underpinning required for validly combining these references. Consequently, this rationale impermissibly uses the Appellants’ disclosure as a blueprint or in hindsight for the rejection. Because the Examiner has not provided an articulated reason with some rational underpinning to combine the prior art elements in the manner claimed, the Examiner has failed to establish a *prima facie* case of obviousness and the rejection under 103(a) should be overruled at least for this reason.

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VIII. CONCLUSION

Appellants contend that claim 30 was improperly rejected because the single cited reference does not disclose all of the essential elements of the claim arranged as required by the claim and in as complete detail as in the claim.

Appellants contend that claims 1-7, 9, 11-27, and 31-36 were improperly rejected because the applied references, alone or in combination, do not teach or suggest all of Appellants' claim limitations, there is no articulated reason with some rational underpinning to modify or combine reference teachings, and/or there is no reasonable expectation of success in combining the references. Such a suggestion or motivation could be possible only in hindsight and in light of Appellants' teachings.

Each of these reasons alone distinguishes Appellants' claims from the cited references and makes Appellants' claims non-obvious in light of the cited references.

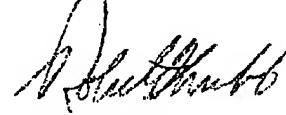
Overruling of the Examiner's rejections of claims 1-7, 9, 11-27, and 30-36 is respectfully requested.

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**AUTHORIZATION TO PAY AND PETITION
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If any charges or fees must be paid in connection with the foregoing communication (including but not limited to the payment of an extension fee or issue fees), or if any overpayment is to be refunded in connection with the above-identified application, any such charges or fees, or any such overpayment, may be respectively paid out of, or into, the Deposit Account No. 08-2025 of Hewlett-Packard Company. If any such payment also requires Petition or Extension Request, please construe this authorization to pay as the necessary Petition or Request which is required to accompany the payment.

Respectfully submitted,



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IX. CLAIMS APPENDIX

1. A method of determining information regarding at least one physical printer available to receive a print job from a client computer, comprising:
 - calling a general printer driver directly from an application executed by the client computer;
 - transmitting a query from the client computer to a server via a network for an identification of the at least one available physical printer;
 - receiving the identification of the at least one available physical printer from the server;
 - selecting a single one of the identified physical printers to receive the print job;
 - after the selecting, downloading from the server a file used to convert print data into a format specific to the selected physical printer; and
 - wherein the general printer driver is accessible as a destination printer in a print menu, and wherein the general printer driver is configured to launch a printing agent to initiate the transmitting when the general printer driver is selected as the destination printer.
2. The method according to claim 1, further comprising:
 - launching a printing agent with the general printer driver, the printing agent generating the query transmitted from the client computer to the server for the identification.
3. The method according to claim 2, wherein the general printer driver is a PostScript printer driver.
4. The method according to claim 1, wherein the downloaded file is a printer description file and the method further comprises overwriting a generic printer description file with the downloaded printer description file and converting application specific data to be printed to printer specific data using the downloaded printer description file.

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5. The method according to claim 4, wherein the generic printer description file is temporarily overwritten until completion of the conversion.
6. The method according to claim 1, wherein the identification is a list of printers.
7. The method according to claim 6, wherein the list of printers includes information from one or more of a physical location, a printer capability and a network address.
9. A client computer adapted for communication with a network, the network having a server and at least one physical printer available to receive a print job, the client computer having a utility for determining information regarding the at least one available physical printer comprising:
 - means for calling a general printer driver directly from an application executed by the client computer;
 - means for transmitting a query to the server via a network for an identification of the at least one available physical printer;
 - means for receiving the identification of the at least one available physical printer from the server;
 - means for selecting a single one of the identified physical printers to receive the print job;
 - means for, after the selecting, downloading from the server a file used to convert print data into a format specific to the selected physical printer; and
 - wherein the general printer driver is accessible as a destination printer in a print menu, and wherein the general printer driver is configured to launch a printing agent to initiate the transmitting when the general printer driver is selected as the destination printer.
11. The client computer according to claim 9, wherein the downloaded file is a printer description file and the client computer further includes means for overwriting a generic

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printer description file with the downloaded printer description file and means for converting application specific data to be printed to printer specific data using the downloaded printer description file.

12. The client computer according to claim 11, wherein the generic printer description file is temporarily overwritten until completion of the conversion.

13. The client computer according to claim 9, wherein the identification of the at least one available printer received from the server is a list of printers including information from one or more of a physical location, a printer capability and a network address.

14. The client computer according to claim 9, further comprising means for displaying the identification of the at least one available physical printer for a user to select the selected physical printer.

15. A program embodied in a computer readable medium to determine information regarding at least one physical printer available to receive a print job from a client computer, comprising:

general printer driver code accessible as a destination printer in a print menu of an application executed by the client computer, the general printer driver code directly callable by the application when selected as the destination printer; and

printing agent code launchable by the general printer driver code, the printing agent code including

code that transmits a query from the client computer to a server via a network for an identification of the at least one available physical printer;

code that receives an identification of the at least one available physical printer from the server; and

code that, after selection of a single one of the identified physical printers to receive the print job, downloads from the server a file used to convert print data into a format specific

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to the selected physical printer.

16. The program according to claim 15, wherein the general printer driver code is called from the application in response to a print command entered by a user.

17. The program according to claim 16, wherein the general printer driver is a PostScript printer driver.

18. The program according to claim 15, wherein the downloaded file is a printer description file and the program further comprises code that overwrites a generic printer description file with the downloaded printer description file so that a printer driver can convert application specific data to be printed to printer specific data using the downloaded printer description file.

19. The program according to claim 18, wherein the generic printer description file is temporarily overwritten until completion of the conversion.

20. The program according to claim 15, wherein the identification of the at least one available physical printer received from the server is a list of printers.

21. The program according to claim 20, wherein the list of printers includes information from one or more of a physical location, a printer capability and a network address.

22. The program according to claim 15, further comprising code that displays the identification of the at least one available printer for a user to select the selected physical printer.

23. A program embodied in a computer readable medium for execution by a server to

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enable a client computer to determine information regarding at least one physical printer available to receive a print job from the client computer, comprising:

code that receives a query from the client computer via a network for an identification of the at least one available physical printer, the query initiated by an application executed by the client computer directly calling a general printer driver, the general printer driver accessible as a destination printer in a print menu and configured to launch a printing agent to initiate the query when the general printer driver is selected as the destination printer;

code that transmits an identification of the at least one available physical printer to the client computer; and

code that, after selection of a single one of the identified physical printers to receive the print job, transmits a file to the client computer, the file used to convert print data into a format specific to the selected physical printer.

24. The program according to claim 23, wherein the downloaded file is a printer description file.

25. The program according to claim 23, wherein the identification of the at least one available physical printer is a list of printers.

26. The program according to claim 25, wherein the list of printers includes information from one or more of a physical location, a printer capability and a network address.

27. The program according to claim 23, further comprising code that polls network devices to determine the identification of the at least one available physical printer.

30. A method of determining information regarding at least one printer available to receive a print job from a client computer, comprising:

calling a general printer driver directly from an application executed by the client

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computer;

transmitting a query from the client computer to a server via a network for an identification of the at least one available printer;

receiving an identification of the at least one available printer from the server;

downloading a file from the server used to convert print data into a format specific to a selected one of the at least one available printer; and

wherein the general printer driver is accessible as a destination printer in a print menu, and wherein the application is configured to launch a printing agent to initiate the transmitting when the general printer driver is selected as the destination printer.

31. A method of determining information regarding at least one printer available to receive a print job from a client computer, comprising:

providing a general printer driver on the client computer accessible as a destination printer in a print menu;

selecting the general printer driver as the destination printer directly from an application executed by the client computer;

responsive to the selecting, launching a printing agent on the client computer from the general printer driver;

transmitting a query from the printing agent to a server via a network for an identification of the at least one available printer;

receiving at the client computer an identification of the at least one available printer from the server in response to the query;

selecting, via the general printer driver, a single one of the at least one available printer to print the print job; and

after selecting the printer, downloading from the server to the client computer a file configured to convert the print job into a format specific to the selected printer; and

printing the print job on the selected printer.

32. The method of claim 1, comprising:

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using the downloaded file, converting the print data into the format specific to the selected one of the at least one available printer; and
printing the converted print data on the selected physical printer.

33. The method according to claim 1, wherein the transmitting is performed after the calling.

34. The method according to claim 1, wherein the selecting is performed by a user.

35. The method according to claim 30, wherein the transmitting is performed after the calling.

36. The method according to claim 31, wherein the transmitting is performed after the selecting the general printer driver.

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X. EVIDENCE APPENDIX

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XI. RELATED PROCEEDINGS APPENDIX

None

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